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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,458	05/08/2001	Y. Tom Tang	PF-0636 USN	4361

7590  
Incyte Genomics  
3160 Porter Drive  
Palo Alto, CA 94304

09/12/2002

EXAMINER
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O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/12/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/831,458

Applicant(s)

TANG ET AL.

Examiner

Eileen B. O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group A, claim(s) 1-6, 9-15 and 19, drawn to polypeptides, polynucleotides encoding the polypeptides, vectors, host cells, method of recombinantly producing the polypeptide and method of treating or preventing a disorder comprising administering a polypeptide.

Group B, claim(s) 7 and 8, drawn to a method for detecting a polynucleotide by hybridization.

Group C, claims 16, 17 and 18, drawn to antibody, agonist and antagonist to a polypeptide of Group A.

Group D, claim 20, drawn to a method of treating or preventing a disorder comprising administering an antagonist to a polypeptide of Group A.

2. The inventions listed as Groups A-D do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polypeptides, polynucleotides and vectors of Group A are structurally and functionally different chemical compounds from the antibody, agonist and antagonist of Group C. Each of which can be made and used without the other compound. Lack of unity is shown because these compounds lack a common utility which is based upon a structural feature which has been identified as the basis for that common utility. The methods of detecting a polynucleotide by hybridization and treating or preventing a disorder

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comprising an antagonist to a polypeptide of Group A also lack the same or corresponding special technical features because the polynucleotides can be used in methods other than detection, such as gene therapy or recombinant production of protein, and the method of treatment with antagonist does not use the polypeptide of Group A.

***Further Restriction Within Groups A-D***

3. For the group elected from Groups A-D, further restriction *within* the elected group is required, as follows:

Applicant is advised that claims 1 and 9 are improper Markush claims because the elements recited therein are different proteins and encoding nucleic acids, which do not serve common functions which are based upon a common property or special technical feature not found in the prior art. The proteins are patently distinct, having different amino acid sequences, homologies to different proteins, and therefore the cDNAs encoding them and antibodies, agonists, antagonists to them and methods of using are also patently distinct.

Applicant is required to elect one polypeptide (and encoding polynucleotide) from those listed in Table 1 on pages 57-58 of the instant specification.

**Applicant is advised that this is not a species election.**

Although the classifications these various polypeptides, polynucleotides, antibodies and methods of use are overlapping, for instance 536/23.1 or 530/350, each represents a patentably distinct product, with different sequences and structures and with distinct physical and functional characteristics. Further, the search for more than one product would be burdensome, because

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each and requires a separate search which is not required for any of the other sequences.

Accordingly, restriction is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner

*Yvonne Eyer*  
YVONNE EYLER, PH.D  
SUPERVISORY PATENT EXAMINER  
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